

### REMARKS

The last Office Action has been carefully considered.

It is noted that claims 1-15 are rejected under 35 U.S.C. 103(a) over the European patent document '299.

Claims 1, 2, 5-11 and 13-16 are rejected under 35 U.S.C. 103(a) over the European patent document '527.

Also, claim 1 is rejected on the grounds of non statutory obviousness type double patenting as being unpatentable over claim 2 of copending application serial no. 10/578,201 and 10/301,046.

In connection with the Examiner's rejection of the claims, applicants amended claims 1 and 11, the broadest claims on file, related to the inventive insertion tool and the inventive system, to more clearly define the present invention and to distinguish it from the prior art.

In view of the Examiner's rejection of the claims on the grounds of non statutory obviousness type double patenting, it is respectfully submitted that U.S. patent application serial no. 10/578,201 discloses a tool receiving device of

an angle grinder for receiving an insert tool 14. However, this reference deals with the tool receiving device which has a drive shaft 16 with at least one non-chip removing formed form locking element 100 positive fit locking connection in the peripheral direction (50, 52) with a means of the drive device (12) for drive torque transmission. A specific construction or dimensioning of a hub of the insert tool on the fastening means on a partial circle with a special radius of between 12 mm and 25 mm as in the applicant's invention is not disclosed in this reference and also can not be derived from it.

It is therefore believed to be clear that there is no direct connection between the invention disclosed in the U.S. patent application 10/578,201 and the present invention, and therefore there is no reason for a double patenting of the present invention with regard to the invention disclosed in the above mentioned patent application.

The U.S. patent application serial no. 10/311,046 also does not disclose the subject matter of the present invention, since the invention disclosed in this reference deals with an electrically operated hair removal device.

It is therefore believed that there are no grounds for non statutory obviousness-type double patenting rejection, and the Examiner's rejection for these reasons should be considered as not tenable and should be withdrawn.

The European patent document '299 discloses an insertion tool 14 for an angle grinder 32. The insertion tool 14 has a hub 42 with at least one first fastening means 76 for fastening the hub 42 to a driving device 12 of the angle grinder 32. The first fastening means 76 is arranged on a partial circle as shown in Figure 2. However, this reference does not disclose that the fastening means is located on such a partial circle which is dimensioned to provide reliable and easy installation of the insertion tool on the angle grinder using a keyless system that enables handy use with sufficient working material and is equal to between 12 mm and 25 mm, on which partial circle the first fastening means is arranged on the hub.

The European patent document '527 discloses an insertion tool 12 for an angle grinder 44. The insertion tool 12 has a hub 40 with a first fastening means 76, 82 for fastening the hub 40 on a driving device 10 of the angle grinder 44, wherein the first fastening means 76, 82 is arranged on a partial circle as shown in Figures 5 and 6. This reference however does not disclose that the first fastening means is located on a partial circle with a radius dimensioned to provide reliable and easy installation of the insertion tool on the angle grinder using a keyless system that enables handy use with sufficient working material and equal to between 12 mm and 25 mm.

The present invention deals with an insertion tool as well as with a system composed of an insertion tool with a hub and a driving device for an angle grinder, in which the first fastening means is located on a partial circle with a radius dimensioned to provide a reliable and easy installation of the insertion tool on the angle grinder using a keyless system that enables handy use with sufficient working material and equal to between 12 mm and 25 mm.

The radius between 12 mm and 25 mm is determined in particular for a quick gripping system for fastening the insertion tool 12 to a driving device 22 of an angle drive grinder 2 that enables handy use with sufficient working material as specifically explained in the specification in the paragraph bridging pages 1 and 2. This specific radius 56 of the partial circle 54, on which the first fastening means is arranged, provides an especially efficient and at the same time place and space-saving torque transmission from the drive device 22 of the angle grinder 2 to the insertion tool 12.

The quick gripping system, which is assembled from the drive device 22 of the angle grinder 2 and a hub 16 of the insertion tool 12 poses high requirements for its construction and development. The insertion tool 12 or a hub 16 of the insertion tool 12 must be designed so that a fast and in particular keyless exchange of the insert tool 12 with the drive device 22 is possible and at the same time during a working use of the angle grinder 2 with the insert tool 12

an advantageous force distribution in the insert tool 12 and to the drive device 22 is guaranteed. A quick gripping system which has such advantages requires a specific, balanced dimensioning of the radius 56 of the partial circle 54, on which the first fastening means is arranged on the hub 16, for which purpose the radius 56 of the partial circle 54 is specifically selected to be between 12 mm and 25 mm.

This selection of the partial circle 54 with the radius 56 between 12 mm and 25 mm is not disclosed in the references applied by the Examiner. In addition, none of the references discloses any hint or suggestion for a person skilled in the art for the new features of the present invention, since they generally disclose an arrangement and a shape and a design of the first fastening means but do not disclose an exact arrangement of the first fastening means on the hub, which can provide a fast exchange of the insertion tool with a simultaneous advantageous force transmission in the insert tool and in the drive device during an operation of the angle grinder.

Since the references do not disclose any hint or suggestion for such features, therefore in order to arrive at the applicant's invention from the teachings of the references, the references have to be fundamentally modified, and in particular by including into them the features which were first proposed by the applicants. However, it is known that in order to arrive at a claimed invention,

by modifying the references the cited art must itself contain a suggestion for such modification.

This principle has been consistently upheld by the U.S. Court of Customs and Patent Appeals, which for example, held in its decision in *re Randol and Redford* (165 USPQ 586) that

Prior patents are references only for what they clearly disclose or suggest, it is not a proper use of a patent as a reference to modify its structure to one which prior art references do not suggest.

Also, as explained herein above, the present invention provides for the highly advantageous results which can not be accomplished by the constructions disclosed in the references. It is well known that in order to support a valid rejection the art must also suggest that it would accomplish applicant's results. This was stated by the Patent Office Board of Appeals in the case *Ex parte Tanaka, Marushma, and Takahashi* (174 USPQ 38), as follows:

Claims are not rejected on the ground that it would be obvious to one of ordinary skill in the art to rewire prior art devices in order to accomplish applicant's result, since there is no suggestion in prior art that such a result could be accomplished by so modifying prior art devices.

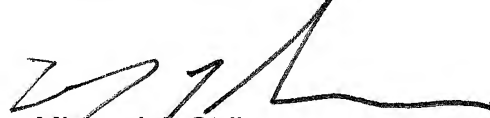
In view of the above presented remarks and amendments, it is believed that claims 1 and 11, the broadest independent claims, should be considered as patentably distinguishing over the art and should be allowed.

As for the dependent claims, these claims depend on the corresponding independent claims, they share their allowable features, and therefore they should be allowed as well.

Reconsideration and allowance of the present application is most respectfully requested.

Should the Examiner require or consider it advisable that the specification, claims and/or drawings be further amended or corrected in formal respects in order to place this case in condition for final allowance, then it is respectfully requested that such amendments or corrections be carried out by Examiner's Amendment, and the case be passed to issue. Alternatively, should the Examiner feel that a personal discussion might be helpful in advancing this case to allowance; he is invited to telephone the undersigned (at 631-549-4700).

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Michael J. Striker', written over a horizontal line.

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